

REMARKS

In the Office Action mailed May 2, 2007, the Examiner rejected claims 14 and 18-20 as directed to non-statutory subject matter under 35 U.S.C. § 101; rejected claims 1-3, 6, 8, 9, 10-12, 19 and 20 under 35 U.S.C. § 102(b) as unpatentable over WO 01/88703 A1 to Hatcher, Clark et al. (Clark); rejected claims 4, 5, 13, 15, and 17 under 35 U.S.C. § 103(a) as unpatentable over Clark; and rejected claims 7 and 16 under 35 U.S.C. § 103(a) as unpatentable over Clark in view of U.S. Patent No. 7,000,182 to Iremonger et al. (Iremonger).

By this amendment, Applicants amend claims 1, 14, and 18 to more clearly define the claimed features and to include the subject matter of canceled claims 2 and 3; and amend claims 14 and 18 in response to the rejection under 35 U.S.C. § 101.

Regarding the rejection under section 101, to expedite prosecution (and without acquiescing to the Examiner's contention that signals are not currently patentable subject matter), Applicants have amended claims 14 and 18 to recite "machine-readable storage device." Therefore, the rejection under 35 U.S.C. § 101 of claims 14 and 18-20 should be withdrawn.

Rejection of claims 1-3, 6, 8, 9, 10-12, 19, and 20 under 35 U.S.C. §102(b)

The Examiner rejected claims 1-3, 6, 8, 9, 10-12, 19, and 20 under 35 U.S.C. § 102(b) as unpatentable over Clark. Applicants respectfully traverse this rejection.

Amended claim 1 recites a combination of features including, among other things, "extracting, using a filter, at least one user-changeable code portion from the existing informational display, wherein the at least one input field is bound to the extracted code

portion." The Examiner alleges that Clark teaches this feature "inherently". Applicants disagree.

Specifically, the Examiner states that "modification of certain portions of the template to incorporate the current report data to be displayed inherently involves extracting at least one user-changeable code portion from the template." Office Action, p.

4. Inherency requires that the Examiner's allegation necessarily be the case, and Applicants submit that a template modification does not necessarily require extracting at least one-user changeable code portion from a template, as the Examiner alleges.

Specifically, the M.P.E.P. states:

The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (reversed rejection because inherency was based on what would result due to optimization of conditions, not what was necessarily present in the prior art); *In re Oelrich*, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981). "To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.' " *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999)

Moreover, there is no indication in Clark that a filter is used to perform the "extracting" feature noted above. As such, Clark is completely silent with respect to the above-noted "extracting" feature. In view of the foregoing, Claim 1 and claims 4-13, by reason of their dependency from independent claim 1, are not anticipated by Clark. Therefore, the rejection under 35 U.S.C. § 102(b) of claim 1 as well as claims 6, 8, 9, and 10-12, at least by reason of their dependency from independent claim 1, should be withdrawn.

Independent claims 14, 15, and 18, although of different scope, include features similar to those noted above for claim 1. For at least the reasons given above for claim 1, the rejection under 35 U.S.C §102(b) of independent claims 14, 15, 18, and claims 19-20, at least by reason of their dependency from corresponding independent claim 18, should be withdrawn.

35 U.S.C. §103(a) Rejection of claim 4, 12-15, and 19

The Examiner rejected claims 4, 5, 13, 15, and 17 under 35 U.S.C. § 103(a) as unpatentable Clark. Applicants respectfully traverse this rejection.

Claims 4, 5, and 13 each depends from independent claim 1 and each includes all the features recited therein including, among other things, “extracting, using a filter, at least one user-changeable code portion from the existing informational display, wherein the at least one input field is bound to the extracted code portion.” For at least the reasons given above with respect to claim 1, Clark fails to disclose the noted feature of claims 4, 5, and 13. Claims 4, 5, and 13 are thus patentable over Clark, and the rejection of those claims under 35 U.S.C. § 103(a) should be withdrawn.

Claim 15 recites a combination of features including, among other things, “extracting at least one user-changeable code portion from the template file according to the layout and placing the code portion in an XML file.” For at least the reasons given above with respect to claim 1, Clark fails to disclose the noted feature of claim 15. Claim 15 and claim 17, at least by reason of its dependency from independent claim 15, are thus patentable over Clark, and the rejection of those claims under 35 U.S.C. § 103(a) should be withdrawn.

35 U.S.C. §103(a) Rejection of claims 7 and 16

The Examiner rejected under 35 U.S.C. § 103(a) claims 7 and 16 as unpatentable over Clark in view of Iremonger.

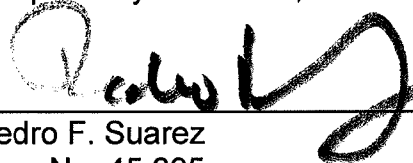
Claim 7 depends from claim 1, and claim 16 depends from claim 15. For at least the reasons noted above, Clark fails to disclose or suggest at least the “extracting” features included in each of those claims by virtue of their dependency from independent claims 1 and 16. Moreover, Iremonger fails to cure the noted-deficiencies of Clark. Claims 7 and 16 are thus patentable over Clark and Iremonger, whether taken alone or in combination, and the rejection of those claims under 35 U.S.C. §103(a) should be withdrawn.

CONCLUSION

It is believed that all of the pending claims have been addressed in this paper. However, failure to address a specific rejection, issue or comment, does not signify agreement with or concession of that rejection, issue or comment. In addition, because the arguments made above are not intended to be exhaustive, there may be reasons for patentability of any or all pending claims (or other claims) that have not been expressed. Finally, nothing in this paper should be construed as an intent to concede any issue with regard to any claim, except as specifically stated in this paper, and the amendment of any claim does not necessarily signify concession of unpatentability of the claim prior to its amendment.

On the basis of the foregoing amendments, Applicants respectfully submit that the pending claims are in condition for allowance. If there are any questions regarding these amendments and remarks, the Examiner is encouraged to contact the undersigned at the telephone number provided below. No fee is believed to be due, however, the Commissioner is hereby authorized to charge any fees that may be due, or credit any overpayment of same, to Deposit Account No. 50-0311, Reference No. 34874-095-UTIL/2004P00159US

Respectfully submitted,



Pedro F. Suarez
Reg. No. 45,895

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Mintz, Levin, Cohn, Ferris, Glovsky and Popeo, P.C.
9255 Towne Centre Drive, Suite 600
San Diego, CA 92121
Customer No. 64280
Tel.: 858/320-3040 - Fax: 858/320-3001